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IN THE

Supreme Court of the United States

OCTOBER TERM, 1964

No. 374

MONROE AUTO EQUIPMENT COMPANY,
Petitioner,

v.

HECKETHORN MANUFACTURING & SUPPLY COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Opinions Below

The opinions of the Court of Appeals appear at 332 F. 2d 406 (Appendix A, infra i-xx; 141 USPQ 549) and at 305 F. 2d 375 (81a*; 135 USPQ 1). The District Court's opinions appear at 214 F. Supp. 704 (83a; 137 USPQ 148) and 204 F. Supp. 249 (46a; 133 USPQ 34).

*An arabic number if followed by "a" designates a page in the printed "Appellant's Appendix", while if followed by "b" designates a page of the printed "Appendix to Defendant-Appellee's Brief". Nine copies of each of these have been filed pursuant to this Court's Rule 21(4), so that pursuant to its Rule 23(1)(i) only opinions not therein printed have been appended hereto.

Jurisdiction

The judgment of the Court of Appeals was dated May 14, 1964. This Court's jurisdiction is invoked under 28 U. S. C. § 1254(1).

Question Presented

Was a jury trial constitutionally denied (on the ground a verdict might have been directed) when the court, without ever submitting anything to a jury, and necessarily to its judgment, not only decided disputed matters of primary fact but as well resolved matters of weight and credibility, and drew inferences, all in ways with which other reasonable men could disagree?

Constitutional and Statutory Provisions

The constitutional provision involved is the Seventh Amendment to the Constitution of the United States (App. B, infra xxi). The statutory provisions involved are 35 U. S. C. §§ 102(a) and 103 (App. B, infra xxi).

Statement of the Case

This is an action for patent infringement.*

While other claims as well were asserted by petitioner below**, this petition is limited to petitioner's claim for infringement of Brooks Walker United States Patent No. 2,896,938, of which plaintiff is assignee (249a-250a).

On the original complaint equitable as well as legal relief, arising out of the same circumstances, was involved***

*The jurisdiction of the District Court arose of course under the patent laws of the United States (28 U. S. C. § 1338(a)).

**Together the original and supplemental complaints asserted claims for infringement of three patents and for unfair competition (5a-19a). The claim as to one patent was dismissed on plaintiff's motion before trial (45a).

***As in *Dairy Queen* v. *Wood*, 369 U. S. 469, 475 (1962) and, after counterclaim was filed, *Beacon Theatres* v. *Westover*, 359 U. S. 500, 504 (1959).

(9a). Before defendant answered, the prayer for any equitable relief was deleted (17a). Nevertheless, the District Court granted (44a) defendant's motion to strike (29a) plaintiff's timely demand for jury trial (10a), saying (32a-33a):

> "I don't think that a jury is really appropriate in a patent case. . . . This statement appears in many decisions. . . . [T]he courts do not consider it appropriate. . . ."

Following a trial without jury the District Court made *29 "Findings of Fact"* bearing on the validity of the patent now before this Court (1 through 17, 28 through 36, and 40 through 42 [47a-50a; 53a-55a; 56a-57a]), and thereon concluded it to be invalid as (1) anticipated (35 U. S. C. § 102(a), App. xxi) by an unpatented Knoedler device (58a), (2) unobvious (within 35 U. S. C. § 103, App. xxi) over other prior art (57a-58a), and (3) not adequately disclosed sufficiently early to the Patent Office (57a).

The Court of Appeals vacated the judgment (59a) entered pursuant thereto, and (81a) "remanded for consideration in the light of *Dairy Queen, Inc.* v. *Wood*, 369 U. S. 469 and *Shubin* v. *United States District Court*, 369 U. S. 660."

On remand, the District Court did not question that its action in striking the demand for jury trial had been, as matters then stood, improper under the cited decisions of this Court (85a-86a), nor has respondent (App. A, *infra* viii). However, the District Court nevertheless summarily denied a new trial before a jury on the ground that "there was no prejudice" (86a). This, said the District Court, was because, as to two of the three grounds on which it had previously relied (significantly, the District Court now

dropped its holding of invalidity based on the Knoedler device's "anticipation", 86a, 87a): "This court in another trial would be obliged, as before, to conclude as a matter of law that claims herein are invalid in view of the undisputed evidence."

The Court of Appeals treated the District Court as having said "in effect" that "it would have been required to direct a verdict", and agreed that this was a proper basis on which to deny a jury trial (App. viii). However, in making its own selection of the grounds on which a verdict might properly have been directed, the Court of Appeals (App. ix-xvii) agreed with the District Court only as to the obviousness ground, and resuscitated the ground of anticipation by the "Knoedler Device" dropped by the District Court.*

Great as has been the impact, in the practical world of events, of the device the Patent Office rewarded by grant by the patent thus struck down, it is nevertheless a very simple one.**

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*The original disclosure's import, in the full context of events including technological ones, would seem plainly to have been at least a matter as to which reasonable men might draw a favorable inference, within the rules of law discussed infra. Accordingly, and inasmuch as the Court of Appeals dropped this ground of decision, we do not mention it further herein.

**Perhaps this structural simplicity has been a source of confusion below. But any temptation to confuse structural simplicity with conceptual obviousness is as unsound as it seems pervasive. As the great (among other things, patent) Judge Learned Hand said in *Gillman v. Stern*, 114 F. 2d 28, 30 (2 Cir. 1940), cert. den'd 311 U. S. 718:

> "If . . . an old article must be physically changed, even slightly, . . . , the statute [i.e., the parts of it concerned with "anticipation" or "novelty", now 35 U. S. C. § 102] is satisfied. In that case the only question open is whether the discovery of the new use demands enough original thought to be deemed an invention [i.e., is "unobvious" within what is now 35 U. S. C. § 103]. [T]he ingenuity needed for the new conception, not the amount of physical readjustment, is the test of a valuable 'discovery.'"

(*footnote cont'd*)

Walker's contribution was a disclosure of the desirability of a suspension device in which an elongated nonmetallic (e.g., rubber) sleeve was interposed between a hydraulic shock absorber and a coil spring surrounding it. The sleeve was disclosed as pretty much filling, along its length, the annular gap between spring and shock absorber, and naturally resisted any tendency of the two to move toward each other or out of concentricity.*

The desirability of a suspension device with a coil spring (for support) surrounding a shock absorber (for dampening action) had long been recognized. Thirteen patents (going back up to 20 years), an advertisement, and several attempted actual uses of such devices were in evidence.**

This Court has in leading decisions enforced this rule to uphold patents in which structural simplicity had led astray lower courts: e.g., *Eibel Co.* v. *Paper Co.*, 261 U. S. 45 (1923).

*The single drawing of the patent shows sleeve 86 between the rock guard portion 11 of a shock absorber and spring 85 (249a). Only claims 2 and 3 (250a) are in issue, and the latter is illustrative:

> "3. In a suspension device, a hydraulic direct-acting tubular shock absorber having relatively movable telescopic parts, a coil spring sleeved over said shock absorber, the inside diameter of said spring being larger than the outside diameter of said shock absorber, an elongated nonmetallic tubular spacer sleeve fitted over said shock absorber and disposed in the space between said shock absorber and said coil spring, said spacer sleeve resisting lateral movement of the coil spring so that said shock absorber and coil spring are maintained in spaced substantially concentric relationship."

**The patents were (cited to their beginning pages, with the earliest date of record to which each traced): United States Patents 2,158,488 (1936; 485a), 2,321,832 (1941; 551a), 2,432,554 (1946; 79b), 2,621,919 (1946; 557a), 2,653,681 (1949; 514a), 2,866,713 (1952; 564a), and 2,756,045 (1953; 525a); British Patents 435,361 (1934; 143b), 565,630 (1943; 571a), and 719,661 (1952; 548a); French Patents 1,055,393 (1951; 535a) and 1,059,988 (1952; 542a); and Italian Patent 467,071 (1950; 59b). The advertisement was for a TAVO product, in a 1952 French magazine (133b). At least the first Knoedler automobile suspension device, said to have been made in 1953, was admittedly of this character (152a). Prior to knowledge

(footnote cont'd)

Despite this long attention to the desirability of spring-around-shock suspensions, nothing in the prior art suggested interposing a sleeve like Walker's.

Yet simple as this and the resulting combination were, there was provided an enormously successful device. Plaintiff, which introduced such a device in 1957 (143a), sold over Twelve Million Dollars' worth in the first three and a half years (143a).

In the first action adjudicated, a jury returned a verdict that the patent was valid and infringed, and judgment accordingly was entered (296a), despite motion for judgment n. o. v. (136a, undisputed).*

Despite the litigation carried through on the merits, the patent has met with considerable industry acquiescence.**

Also bearing on whether or not Walker's contribution was "obvious" was conflicting testimony as to whether the sleeve functioned solely to prevent noise (e.g., 25b, 91a,

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of plaintiff's product or Walker's teaching, not only did Knoedler fix on (at least for the time being, in 1956) such a device (170a), but defendant here tried and dropped such a device, in 1955 (172a, 187a).

*Damages of only $1 were awarded, so far as appears owing to inadequacy of proof as to marking and notice (35 U. S. C. § 287).

In subsequent litigation, the patent was held invalid on the same two grounds relied on by the Court of Appeals here, by the Ninth Circuit Court of Appeals, affirming, *Monroe Auto Equipment Company* v. *Superior Industries, Inc.*, 332 F. 2d 473 (9 Cir. 1964). Petitioner will file a separate Petition for Certiorari shortly in the latter action, which while related to this one is a non-jury action presenting specifically different questions.

**_Seven_ defendants in as many further different actions (288a, 314a, 324a, 326a, 328a, 330a, 332a) entered into *consent decrees* holding this patent (five of them so held as to a second patent as well) valid and infringed and granting injunctive relief. *Five non-exclusive license agreements* calling for substantial royalties under this and another patent were signed (282a, 290a, 303a, 308a, 316a), three of them with companies enjoined, and these agreements produced over Seven Thousand Dollars in *royalties* in 1960 alone (135a, 137a, 138a). Plaintiff itself, in return for assignment of this and the other patent, made an initial payment of $10,000, and undertook a continuing royalty obligation under which royalties of almost $100,000 accrued in the first year and a half (132a) alone.

and 98a, which indicated a centering and anti-buckling effect on the spring, contrasted with 90a and part of 152a), and expert testimony elicited by defendant as to obviousness assuming the evidence supported the noise-only function inference (16b, 57b).

As to the alleged full anticipation by a Knoedler device, the extensive and self-contradictory evidence must be characterized in sum thus: (1) no witness even purported to be able to place the sleeved device in a relevant time period by memory, or otherwise than as records made clear; and (2) no record existed that would have made unreasonable a jury's inference that no such device existed in that period.*

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*Whether fully anticipatory Knoedler devices were in the prior art before May, 1954 (the original filing date credited as Mr. Walker's date of invention) turned mainly on the testimony of Mr. Fred Knoedler, a farm equipment manufacturer (144a).

However, the one circumstance to which Mr. Fred Knoedler firmly and repeatedly testified was that (157a): "All I go by is records. . . . [T]hat has been too far away for me to remember." To this effect were at least two additional firm statements of his (145a, 161a). Nor did any other witness pretend to a better memory.

Looking at his "records", they did indicate order in 1953 (76b-77b) of brochures (577a-578a) and catalog sheets (579a-580a) looking toward sale of spring-around-shock suspension devices. However, these materials show no sleeve, as is plain from inspection of them and as Mr. Knoedler at first admitted (170a). No record or direct memory testimony indicated that over a dozen of these brochures and catalog sheets were ever handed out (171a), although in view of their lack of disclosure the point bears more on abandonment than on whether there ever was a sleeved device prior to May, 1954.

Mr. Knoedler thought a total of about six sets of devices had been made up (155a), and that all were "substantially the same" (161a). He first testified blithely that one of those went to Mr. Robertson "in '53, '54" (161a), and when it came out that the Robertson unit could not have been made before 1956 because of certain castings on it, commented on his earlier remark thus (p. 161a): "I found out that by stating things that I don't have records on that I was mistaken on that. . . ." Another of these went to Mr. Truedson, and Mr. Knoedler said "I rather think" it had a sleeve (160a), but Mr. Truedson, who installed it and remembered much about it (239a, 241a), said there was "to my recollection" no "sleeve or something underneath the coil" (241a).

(footnote cont'd)

Reasons for Granting the Writ

Writ should be granted because:

a. plaintiff has been denied its right to a jury trial by a decision in conflict with decisions of this Court including *Dairy Queen* v. *Wood*, 369 U. S. 469 (1962); *Shubin* v. *United States District Court for the Southern District of California*, 369 U. S. 660 (1962); *Simler* v. *Conner*, 372 U. S. 221, (1963); and *U. S.* v. *Esnault-Pelterie*, 299 U. S. 201 (1936);

b. it is of general public importance, particularly since *Shubin*, to make clear that, and how, in substance as well as form the jury trial constitutionally guaranteed is applicable in its full majesty to patent infringement action like others; and

c. the decision below is in conflict with this Court's decision in *Slocum* v. *New York Life Ins. Co.*, 228 U. S. 364 (1913).

The Vital Right to Jury

1. This Court has etched indelibly, in the decisions beginning with *Beacon Theatres*, its continuing concern that the right of jury trial be carried forward in the full vigor contemplated by the framers of the Constitution. In *Beacon*, and subsequently, glosses imposed on the Constitutional

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The remaining testimony was in similar vein. One of Mr. Knoedler's sons also testified that Robertson's devices went back to 1953 before he realized he had to be wrong (234a).

The only scrap of documentary support for Mr. Knoedler's (and, again, no one long pretended to independent memory) building any sleeved device in 1953 was the patent application filed on his behalf that fall (83b, 97b, 99b). That document, offered "in corroboration of . . . this witness' testimony" (152a), is wholly consistent with manufacture differently of any items actually made up in that period.

requirement to limit its sweep were struck down. In *Shubin v. United States District Court for So. Dist. of Cal.*, 299 F. 2d 47 (9 Cir. 1961), the Court noted that (much as did the District Court explicitly here, supra, p. 3), the District Court "recognized that patent suits do not lend themselves readily to trial by jury for obvious reasons"; but its denial of mandamus was vacated by this Court in a unanimous *per curiam* decision. 369 U. S. 660.

Deprivation of Right to Jury's Reasonable Inferences and Views on Weight and Credibility

2. The substantial right to jury trial may be as easily lost by limiting the evidence given the jury (as here) as by restricting the class of actions in which such a trial is available (as in *Beacon Theatres*). This Court has over and over disapproved this approach, as in *Tennant v. Peoria & P. U. Ry. Co.*, 321 U. S. 29, 35 (1944):

> "The focal point of judicial review is the reasonableness of the particular inference or conclusion drawn by the jury. It is the jury, not the court, which is the fact-finding body. It weighs the contradictory evidence and inferences, judges the credibility of witnesses, receives expert instructions, and draws the ultimate conclusion as to the facts. The very essence of its function is to select from among conflicting inferences and conclusions that which it considers most reasonable."

To the same effect were, e.g., *Gunning v. Cooley*, 281 U. S. 90, 94 (1930) and *Lavender v. Kurn*, 327 U. S. 645, 653 (1946).

Improper Denial on Obviousness Issue

3. Although the Court of Appeals said that "whether invention, or unobviousness, poses a question of law or of fact . . . is a question fraught with complexities" (App. v), and conceded that "invention, preliminarily, involves questions of fact" (App. vi), it nevertheless justified withdrawing from the jury the evidence here on the basis of its analysis that (App. vii):

> "Thus what we have in a patent case are three steps: First, a determination of what the prior art was; this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art. *This requires application of a legal criteria* [sic] *and therefore is a question of law.*"*

Even on this analysis, withdrawal of the issue from the jury was unsound.**

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*Emphasis ours throughout.

**Thus an issue on the Court's own "first" part was whether Farmer Patent No. 2,344,858 (152b), which defendant conceded was not a suspension device but a railway air brake cylinder (213a)—the only patent in the enormous record showing any sort of elongated nonmetallic sleeve extending pretty much through the zone between a spring and a cylindrical surface—was from an analogous art and thus a proper one. Perhaps sensing that this very question required drawing an inference the jury might reasonably have drawn to find the Farmer patent from a non-analogous art, the Court sought to avoid the issue by making its own (even less clearly the only reasonable one) inference that the Farmer patent could be brought in on a ground for which the record lacked any support, that "'what was borrowed was a *commonly and generally known expedient in mechanical arts.*'"

4. More fundamentally, the Court of Appeals' conclusion that its entire "final step" was outside the requirement of a jury trial because "a question of law" was unsound. For example, it is well-settled that the existence for a long time of a need, accompanied by a delay in supplying it, tends to show (of course it is not conclusive) that however simple the solution may seem it was not obvious.* A subsidiary primary fact question arises often, and did here (e.g., 191a, 192a), whether there was in fact a significant and long-standing need. Another issue of subsidiary fact that often arises is the extent to which any commercial success achieved** was attributable to (as it arose here, inter alia) this patent rather than to another patent (18b), a good distribution system (38b), or "promotion and advertising" (40b). To prohibit a jury's resolving these primary fact questions because they are subsidiary to what at last may be a question of law cannot meet the constitutional prerogative.

5. The vice of the Court of Appeals' analysis is indeed yet more fundamental, for it seriously usurps the jury's inference-drawing functions. Prior effort and failure, long felt want, commercial success, acquiescence of the industry (with its primary fact issue of just why licenses were taken), the presumption of validity, and other "objective" circumstances of this sort are themselves significant on the question of obviousness for one reason: from them as a whole a reasonable man might make inferences about obviousness.*** As Judge Learned Hand said in *B. G. Corporation* v. *Walter Kidde & Co.*, 79 F. 2d 20, 22 (2 Cir. 1935):

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*E.g., *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 381 (1909).

**Commercial success is at least some evidence of invention. *Goodyear Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279 (1944).

***This Court squarely held the jury entitled to make an inference from a presumption (of due care) in *Tennant* v. *Peoria & P. U. Ry. Co.* 321 U. S. 29, 34 (1944).

> "Often we can truly treat the inquiry as one of fact by observing what went before and what followed. If the combination would have had practical value long before it appeared, if no impediment, technical, or commercial, stood in the way, if during that time others had been at work upon the same subject, and if the invention was at once accepted as an answer to the old need, there is usually just basis for the inference."*

Plainly, beyond the bare facts of what the prior art was, and exactly the thing a patentee did beyond that, lies the further question, often (as here) rich in factual content and basis for differing reasonable inferences, of whether taking the step forward was an easy thing or a difficult one, and to what degree it was either. That in the last analysis just how great this degree is may be a question of law and statutory interpretation is in no way inconsistent. This no doubt explains the numerous cases in which courts have simply said invention was a question of fact (as, it admitted, had the Court of Appeals here, App. vii). Contrariwise, cases can be imagined in which there is no factual dispute and no basis for more than a single inference; that these often

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*The Court went on, in language remarkably apropos:

> "In the case at bar it seems to us that the evidence is at hand to show that Paulson's combination was beyond the scope of even the most skilled routineers. The record is peppered with a score of patents upon spark-plugs distributed more or less evenly over more than fifteen years. They show a manifold ingenuity and all sorts of permutations, but not Paulson's; it is uncommon to find so much ingenuity devoted to so small a device. During that time the motor car was being made in prodigious, almost monstrous quantities, millions upon millions; a new discovery which gave its possessor an exploitable advantage was likely to be the source of great wealth; the stimulus to invention was rarely strong. Moreover, nothing stood in the path; the defendant's very argument may be turned against itself: for Paulson's metals were all being used and were all available commercially; yet they did not suggest this combination, which would have been as serviceable at any time as it has been since the patent issued."

speak generally of invention as a question of law is not surprising. The substantial nature of the issue was thus put (inconsistently with the Court of Appeals' analysis and decision) by this Court in *U. S.* v. ***Esnault-Pelterie,*** 299 U. S. 201, 205 (1936):

> "Validity and infringement are ultimate facts on which depends the question of liability. In actions at law they are to be decided by the jury."

6. The very decision generally credited as the fountainhead of the requirement of "invention", *Hotchkiss* v. *Greenwood,* 11 How. (52 U. S.) 248, 265 (1850) held that a jury was properly charged, on proper instructions, with the task of making an inference as to obviousness.

Improper Denial on Anticipation Issue

7. The Court of Appeals' resolution without benefit of jury of the issue of whether Mr. Knoedler ever made up a sleeved device prior to May, 1954* only underlines how far it was willing to go. If ever issues of credibility, weight, and varying possible inferences by reasonable men existed, they did here (supra 7-8).

Disputed Material Facts

8. It is not as though disputed material facts were lacking, so that summary judgment would have been proper. The slightest consideration on this record makes ineluctably plain that summary judgment would have been quite improper, and understandably defendant made no such

*And, *a fortiori*, whether, if so, he reduced it to practice as a workable device satisfactory to him rather than letting it become an abandoned experiment, as would be required to invoke 35 U. S. C. §102(a), on which the Court relied.

motion. When these issues were submitted to a jury in another case, it held the patent valid and judgment was entered accordingly (supra, p. 6). This Court said recently in reversing *per curiam* a denial of a jury trial, *Simler v. Conner*, 372 U. S. 221, 222-3 (1963):

> "[W]e do not agree . . . that . . . a summary judgment was warranted. . . . [T]he Court of Appeals has ruled that in view of conflicting facts presented by affidavits and depositions . . . summary judgment was not warranted. We accept and do not disturb the ruling . . . since it has ample support in the record."

Procedural Unconstitutionality: *Slocum* Violated

9. This Court held in *Slocum v. New York Life Ins. Co.*, 228 U. S. 364 (1913), that where disputed issues of fact were present the Seventh Amendment precluded entry of j. n. o. v. rather than grant of a new trial, even assuming following a jury trial that verdict should have been directed. While the Court later found adequate historical basis to make an exception in cases where the District Court had in denying a motion for directed verdict reserved the question of its propriety (*Baltimore & C. Line v. Redman*, 295 U. S. 654 [1935]), and made this reservation automatic in the Federal Rules of Civil Procedure, Rule 50(b),* it is plainly inapplicable to a case like this, in which the disputed factual issues were never submitted to the jury in the first

*This Court's regard for the constitutional significance of such a reservation was only underlined by its refusal in 1946 to accept the Advisory Committee's recommendation that this portion of Rule 50(b) be eliminated. Field and Kaplan, "Materials for a Basic Course in Civil Procedure" (Foundation Press 1953), p. 607.

place.* Indeed, this Court has explicitly emphasized the importance of the "precise plan" set forth in Rule 50(b). *Johnson* v. *New York, N. H. & H. R. Co.*, 344 U. S. 48, 52-54 (1952).

Conclusion

The denial here of the constitutionally guaranteed right to jury is so clear, in substantive as well as procedural aspects, that this Court should, and may properly, vacate the judgment below and remand for a new jury trial "under appropriate instructions" just as this was done in *Simler*.

Respectfully submitted,

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*How failure to submit to a jury in the first place is more serious than to direct a judgment n.o.v., as a practical matter, is underlined by these remarks from *New York, New Haven & Hartford Railroad Co.* v. *Dox*, 249 F. 2d 572, 574 (1 Cir. 1957):

> "[W]here the district court . . . has left the case to the jury . . . reversal on appeal would amount to setting our judgment on the facts against both that of the trial judge *and of the jury, an eventuality that naturally makes us hesitate even more.*"

APPENDIX A

Opinion of the United States Court of Appeals for the Sixth Circuit, 332 F. 2d 406 (May 14, 1964)

Before MILLER, CECIL *and* PHILLIPS, Circuit Judges.

HARRY PHILLIPS, Circuit Judge.

This is an appeal from a judgment of the District Court holding invalid certain claims of two patents belonging to plaintiff-appellant.

The Monroe Auto Equipment Company, plaintiff-appellant, hereinafter referred to as plaintiff, brought suit against Heckethorn Manufacturing and Supply Company, defendant-appellee, hereinafter referred to as defendant, charging infringement of Patents No. 2,896,938 and No. 2,912,235, hereinafter referred to, respectively, as patents 938 and 235.

These two patents have had long and arduous journeys through the patent office. The original application which resulted in patent 938 was filed May 6, 1954, and the patent issued on July 28, 1959. Patent 235 was based on an application filed September 30, 1954, and was issued on November 10, 1959. Both of these applications were filed by Brooks Walker. Plaintiff is the owner of the patents as assignee of Walker.

The patents relate to auxiliary suspension devices designed for installation on the rear of an automobile. They are mounted at an inclined angle between the rear axle and the chassis frame, a so-called "sea-leg" mounting. They provide additional load carrying capacity and improve the lateral stability of the car.

The device includes a hydraulic direct acting tubular shock absorber surrounded by a relatively long spring of small diameter, the ends of which are supported on the relatively movable telescopic parts of the shock absorber. A rubber tubular spacer sleeve is positioned around the

shock absorber so as to fit between it and the coil spring. This maintains the spring in a substantially aligned or concentric relationship relative to the shock absorber, and prevents the spring from buckling or thrashing around. In addition, the spacer sleeve prevents the spring from banging against and damaging the shock absorber, and prevents the noise which would result from the metal-to-metal contact between the spring and the shock absorber.

Plaintiff, the world's largest seller of replacement shock absorbers, began marketing this device in May, 1957, under the name of "Load-Leveler's." The product apparently has enjoyed considerable acceptance and commercial success.

In 1959 defendant began selling a device it called the "Level-Ride," the alleged infringer. This too is a combination shock absorber and helper spring. It consists of a telescopic shock absorber disposed within a coil spring. Around the shock absorber and between it and the spring is a tubular rubber sleeve. Since it first went on sale, defendant has changed its device so that it now has two shorter rubber sleeves instead of the one longer sleeve.

At the trial plaintiff limited its charge of infringement to claims 2 and 3 of patent 938 and claim 14 of patent 235. The former refer to the rubber spacer sleeve which fits between the spring and the shock absorber. Claim 14 of patent 235 refers to the so-called "sea-leg" mounting, that is, at an inclined angle between axle and chassis.

In it's original complaint plaintiff sought an injunction, an accounting, and legal relief in the form of damages. Plaintiff also filed a demand for a jury trial. Defendant filed a motion to strike the demand for a jury trial, and this motion was granted by the District Judge, the Honorable Marion S. Boyd. The case was tried to the Court and resulted in a judgment holding both patents invalid. The findings and conclusions of the District Court are reported in 204 F. Supp. 249.

Plaintiff appealed from this judgment and from the order striking the demand for a jury trial. This Court, at 305 F. 2d 375, vacated the judgment and remanded the case for consideration in the light of Dairy Queen, Inc. v. Wood, 369 U. S. 469, 82 S. Ct. 894, 8 L. Ed. 2d 44. In that case the Supreme Court held that a plaintiff is entitled to a jury trial, even in an essentially equitable suit, if any legal relief is sought involving factual questions that need to be resolved.

On remand, the District Court held that the patents were invalid as a matter of law, and that therefore there was no prejudice to the plaintiff in striking the demand for a jury trial. 214 F. Supp. 704.

Plaintiff appeals from this judgment. It also filed in this Court a motion seeking an order that the case be remanded with directions for trial before a jury. This Court denied the motion, saying: "Our previous ruling was not that appellants were entitled to a jury trial . . . but only that the District Court consider the case again in light of the Supreme Court decision." This Court observed that "if the controlling facts of the case were undisputed so that the District Judge had only a legal question to decide, then appellant was not prejudiced by the refusal of the Judge to submit the issues to a jury." Finally, we there said: "Whether the opinion of the District Court, on remand, was correct remains to be determined in this appeal." That time has now come.

First, however, because of the decision below and the posture of this case, we consider the issue of whether patentability involves a question of law or a question of fact. Of course our real concern is not with patentability, a word which is dependent upon other factors and merely describes an end result. Patentability follows, as the night follows the day, if the three requisites of patentability are present: these

are invention, novelty, and utility. Harvey v. Levine, 322 F. 2d 481, 483 (C. A. 6); Maytag Co. v. Murray Corp. of America, 318 F. 2d 79, 81 (C. A. 6); Allied Wheel Products v. Rude, 206 F. 2d 752, 760 (C. A. 6). To paraphrase these requisites more in terms of the statute, to receive a patent there must be an invention which is new and useful. 35 U. S. C. § 101. Thus our real concern is with invention, its meaning, and whether it poses a question of law or fact.

It is virtually a practical impossibility to define adequately that abstraction which we call invention. Long ago the Supreme Court said: "The truth is the word cannot be defined in such a manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill." McClain v. Ortmayer, 141 U. S. 419, 427, 12 S. Ct. 76, 78, 35 L. Ed. 800. This Court consistently has echoed this view. Harvey v. Levine, supra, 322 F. 2d at 485; Coats Loaders & Stackers, Inc. v. Henderson, 233 F. 2d 915, 921 (C. A. 6); Westinghouse Elec. & Mfg. Co. v. Powerlite Switchboard Co., 142 F. 2d 965, 966 (C. A. 6).

Judge Learned Hand concluded that in the final analysis the test of invention called for a subjective determination. Kirsch Mfg. Co. v. Gould Mersereau Co., 6 F. 2d 793, 794 (C. A. 2). Judge Frank said that "a decision as to whether or not a thing is an invention is a 'value' judgment." Picard v. United Aircraft Corp., 128 F. 2d 632, 639 (C. A. 2) (concurring opinion). And another court said "[i]t is a matter of feeling rather than of logic." Warren Telechron Co. v. Waltham Watch Co., 91 F. 2d 472, 473 (C. A. 1).

In spite of the difficulty in defining invention, still we must have objective references and a place from which to

start. For this we turn to the statute, which provides that a patent may not be obtained "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U. S. C. § 103. Telescoped, the test is whether the device would have been obvious to one skilled in the art. Maytag Co. v. Murray Corp. of America, supra, 318 F. 2d at 81; Firestone v. Aluminum Co. of America, 285 F. 2d 928, 930 (C. A. 6); Aluminum Co. of America v. Sperry Products, Inc., 285 F. 2d 911, 917 (C. A. 6), cert. denied, Firestone v. Aluminum Co. of America, 368 U. S. 890, 82 S. Ct. 139, 7 L. Ed. 2d 87.

From this it may be said that invention is synonymous with unobviousness. Thus to say that a device lacks invention and that it is obvious is to state the same legal proposition in two ways. Application of Jacoby, 309 F. 2d 513, 516, n. 3 (C. C. P. A.). While the use of obviousness does not begin to solve the problem of application, at least it gives us a touchstone for the contextual meaning of invention.

We now turn to consider whether invention, or unobviousness, poses a question of law or of fact. At the risk of understatement, this is a question fraught with complexities, and one which has caused some courts recently to engage in extensive analysis. E.g., Armour & Co. v. Wilson & Co., 274 F. 2d 143 (C. A. 7) (separate opinion of Chief Judge Hastings); Bergman v. Aluminum Lock Shingle Corp. of America, 251 F. 2d 801 (C. A. 9) (concurring opinion of Judge Pope).

In Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 71 S. Ct. 127, 95 L. Ed. 162, the Supreme Court held that it is a question of law whether the proper standard of invention has been applied.

This case makes it clear that what we are concerned with here is a matter of statutory construction: that is, interpreting the statute to draw from it the proper criteria for what constitutes invention. Statutory construction, of course, is a question of law. Armour & Co. v. Wilson & Co., supra, 274 F. 2d at 156.

In practice, statutory construction is statutory application. This necessitates the existence of a factual basis to which the law is applied. Thus invention, preliminarily, involves questions of fact.

Therefore, to answer the question posed at the outset, invention is a question of law. However, the legal standard is addressed to a factual content which consists necessarily of questions of fact. This is the view which most courts, especially in recent years, have taken. Tatko Bros. Slate Co. v. Hannon, 270 F. 2d 571 (C. A. 2), cert. denied, 361 U. S. 915, 80 S. Ct. 260, 4 L. Ed. 2d 185; Houston Oil Field Material Co. v. Claypool, 269 F. 2d 134 (C. A. 5); Armour & Co. v. Wilson & Co., supra; Bergman v. Aluminum Lock Shingle Corp. of America, supra; Blish, Mize and Silliman Hardware Co. v. Time Saver Tools, Inc., 236 F. 2d 913 (C. A. 10); Application of Sporck, 301 F. 2d 686 (C. C. P. A.).

As applied to a patent case, this view was best expressed as follows:

> "The conflict between the statement that the question of invention is one of fact and the almost innumerable instances in which the courts have dealt with it as though it were one of law can only be explained by breaking the question of patentable invention down into its component parts: what the prior art was and what the patentee did to improve upon it, and then, whether what the patentee did is properly to be classified as an invention. The nature of the prior art and the nature of what the patentee

did to improve upon it must always be questions of fact. The question of the name to be given to what was done by the patentee, whether it is to be called an invention over the prior art or whether it is not, is a question fundamentally of the meaning of the words used in the statute, and as such would seem to be a question of law." 1 Walker, Patents § 25, at 115 (Deller ed. Supp. 1963, at 34).

Thus what we have in a patent case are three steps: First, a determination of what the prior art was; this involves factual questions. Secondly, there is a determination of what, if any, improvement the patentee has made over the prior art; this will usually turn on expert testimony and therefore is a question of fact. The final step is to determine whether the improvement would have been obvious to one skilled in the art. This requires application of a legal criteria and therefore is a question of law, fully reviewable by the appellate court.

This Court on occasion has said that invention is a question of fact. Maytag Co. v. Murray Corp. of America, 318 F. 2d 79, 81 (C. A. 6); Sterling Aluminum Products, Inc. v. Bohn Aluminum & Brass Corp., 298 F. 2d 538, 540 (C. A. 6); Cold Metal Products Co. v. E. W. Bliss Co., 285 F. 2d 244, 248 (C. A. 6), cert. denied, 366 U. S. 911, 81 S. Ct. 1085, 6 L. Ed. 2d 235. To the extent that the first two steps in the determination of invention involve questions of fact, we think these prior cases are not inconsistent with what we presently hold to be the correct rule. Furthermore, this Court, prior to the above-cited cases, recognized and accepted the proper approach to the problem when it held that "the question of invention is a question of law," but questions of fact may exist which affect the conclusion of law. National Latex Products Co. v. Sun

Rubber Co., 274 F. 2d 224, 238 (C. A. 6), cert. denied, 362 U. S. 989, 80 S. Ct. 1078, 4 L. Ed. 2d 1022.

This, we hold, states the proper view. The essential point is that regardless of how important factual issues are in a particular case, the appellate court should be free to give effect to the general legislative standard. The scope of appellate review would be restricted if invention is treated as a question of fact.

Having decided that, although the ultimate question of invention is a question of law, there are some questions of fact to be decided, how does this affect the present case and plaintiff's right to a jury trial?

Plaintiff first contends that since its complaint presented legal issues involving factual questions, it was entitled to a jury trial in light of the Supreme Court decision in Dairy Queen, Inc. v. Wood, 369 U. S. 469, 82 S. Ct. 894. Defendant concedes that the District Court would have erred in its refusal of a jury trial if the Dairy Queen decision had come down prior thereto. On the remand, the District Court considered the Dairy Queen case and concluded that the plaintiff had not been prejudiced "as a result of the striking of its demand for jury trial." 214 F. Supp. 704, 707. The District Court held that the evidence had been so clear and overwhelming that there were no factual issues to be resolved and the patents were invalid as a matter of law. In effect, the Court said it would have been required to direct a verdict.

We are of the opinion that if the District Court was correct in these initial holdings then the subsequent decision in Dairy Queen would not require a new trial before a jury.

Aside from the Dairy Queen case, plaintiff makes the argument that if there were factual issues to be resolved then it is entitled to have the case reversed and remanded

for a jury trial regardless of the weight of the evidence. In support of this proposition, plaintiff cites a few cases from the Fourth Circuit, particularly Peterson v. Sucro, 93 F. 2d 878, 101 F. 2d 282 (C. A. 4). Even assuming that represents the law in the Fourth Circuit, we are of the opinion that the better reasoned view is to the contrary.

The prevailing, and we think the more logical view, is that denial of a jury trial is not reversible error if the court could have directed a verdict, and there was no evidence to go to the jury. Klein v. Burns Mfg. Co., 245 F. 2d 269 (C. A. 2); Leimer v. Woods, 196 F. 2d 828 (C. A. 8); Tanimura v. United States, 195 F. 2d 329 (C. A. 9). This would seem to follow logically from the rule, also applicable in patent cases, that if the evidence is clear the judge may direct a verdict or enter a summary judgment. Klein v. Burns Mfg. Co., supra; Berkeley Pump Co. v. Jacuzzi Bros., 214 F. 2d 785 (C. A. 9); Packwood v. Briggs & Stratton Corp., 195 F. 2d 971 (C. A. 3), cert. denied, 344 U. S. 844, 73 S. Ct. 61, 97 L. Ed. 657; Walker v. General Motors Corp., 225 F. Supp. 350 (N. D. Cal.).

Thus the question posed on this appeal is whether "the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict." Brady v. Southern Ry. Co., 320 U. S. 476, 479, 64 S. Ct. 232, 234, 88 L. Ed. 239, and further, that such conclusion is the one reached by the District Court.

We now come to the patented device which after all is the subject matter of this case. At the outset we take note of two well-established principles. The first is that in considering the question of obviousness, we must view the prior art from the point in time just prior to when the patented device was made. Many things may seem obvious after they have been made, and for this reason courts should guard against slipping into use of hindsight. We

must be careful to "view the prior art without reading into that art the teachings of appellant's invention." Application of Sporck, 301 F. 2d 686, 689 (C. C. P. A.).

Secondly, we also recognize that a presumption of validity attaches to a patent once it has been issued by the patent office. 35 U. S. C. § 282; Alumninum Co. of America v. Sperry Products, Inc., 285 F. 2d 911, 916 (C. A. 6), cert. denied, 368 U. S. 890. This is only proper because of the complexities of patent law and the expertise of the patent office. See Williams Mfg. Co. v. United Shoe Mach. Corp., 121 F. 2d 273, 277 (C. A. 6), cert. denied, 316 U. S. 364, 62 S. Ct. 1179, 86 L. Ed. 1537. However, the large number of patents declared invalid by the courts bear telling witness to the fact that this presumption is in no way conclusive. The presumption of course is weakened if applicable prior art has not been considered by the patent office. Harvey v. Levine, 322 F. 2d 481, 484 (C. A. 6); Aluminum Co. of America v. Sperry Products, Inc., supra.

Claims 2 and 3 of patent 938, which are in issue, relate to the rubber spacer sleeve which fits between the shock absorber and the coil spring. In the statutory language, it must be determined if this would have been obvious to one skilled in the art.

Prior art French Patent 1,044,393, Italian Patent 467,071, and British Patent 435,361, all relating to automobile suspension devices, each demonstrate a coil spring surrounding a tubular shock absorber. Parenthetically, there is no question but that foreign patents can serve just as effectively to negative invention. Allied Wheel Products v. Rude, 206 F. 2d 752, 759 (C. A. 6). These prior patents make it clear that the disposition of a shock absorber within a spring for a vehicular suspension device is old.

The claims in issue, however, relate to the rubber spacer sleeve. This is used primarily to prevent the spring from

banging against the shock absorber, thereby causing both noise and damage to the shock and spring. Farmer Patent 2,344,858 discloses a rubber sleeve between a coil spring and a tubular metallic element. This was not cited as a reference by the patent office.

The Farmer Patent concerned a brake cylinder, and it is certainly true, as plaintiff contends, that a patent cannot be invalidated by prior patents from a non-analogous art. Allied Wheel Products v. Rude, supra; Cincinnati Rubber Mfg. Co. v. Stowe-Woodward, Inc., 111 F. 2d 239 (C. A. 6). However, assuming, without deciding, that the Farmer Patent is from a non-related art, it does not necessarily follow that its disclosures may be ignored. Allied Wheel Products v. Rude, supra, 206 F. 2d at 756; In re O'Connor, 34 C. C. P. A. 1055, 161 F. 2d 221, 222.

There was testimony that it would have been obvious to insert a rubber sleeve to prevent the metal-to-metal contact and resultant noise of the spring banging against the shock absorber. In other words, the use of rubber to prevent metal-to-metal contact is a well known principle. The Farmer Patent, assuming it is from a non-related art, could still be used as "illustrative of the adaptation of well known scientific principles to practical uses." Application of Mariáni, 37 C. C. P. A. 740, 177 F. 2d 293, 295. Or, as this Court has said: "While it is true that patents have frequently been sustained where mechanical expedients were derived from non-analogous arts and so not obvious, this has not been true where what was borrowed was a common and generally known expedient in mechanical arts." Detachable Bit Co. v. Timken Roller Bearing Co., 133 F. 2d 632, 637 (C. A. 6). See Detroit Stoker Co. v. Brownell Co., 89 F. 2d 422, 424 (C. A. 6).

We are of the opinion that the use of a rubber sleeve to prevent metal-to-metal contact was an obvious mechanical

expediency, and cannot rise to the level of invention. Enterprise Mfg. Co. v. Shakespeare Co., 106 F. 2d 800, 803 (C. A. 6), cert. denied, 309 U. S. 665, 60 S. Ct. 590, 84 L. Ed. 1012.

Plaintiff contends that invention is not limited to the rubber spacer sleeve, but that it lies in plaintiff's unique combination of admittedly old elements. It is of course true that old elements can be combined to create a patentable device. Sparton Corp. v. Evans Products Co., 293 F. 2d 699, 704 (C. A. 6), cert. denied, 368 U. S. 967, 82 S. Ct. 439, 7 L. Ed. 2d 395; Cold Metal Process Co. v. Republic Steel Corp., 233 F. 2d 828, 838-839 (C. A. 6); see Reiner v. I. Leon Co., 285 F. 2d 501, 503 (C. A. 2). Obviously, however, the combination of old elements must possess invention, which, for the reasons herein set forth, we do not find in the instant case.

We conclude that, in view of the prior art, what plaintiff did would have been obvious to one skilled in the art. Therefore, Claims 2 and 3 of Patent 938 are invalid for lack of invention. See United Parts Mfg. Co. v. Lee Motor Products, Inc., 266 F. 2d 20 (C. A. 6).

Before continuing, it may be well to pass upon two other points raised by the plaintiff. First, plaintiff emphasizes the great commercial success of its device, saying that this is evidence of a new and useful invention. Defendant responds by pointing to plaintiff's extensive utilization of advertising. In any event, it seems clear that in a close case commercial success may be a relevant consideration. Aluminum Co. of America v. Sperry Products, Inc., 285 F. 2d 911, 923 (C. A. 6), cert. denied, Firestone v. Aluminum Co. of Amer. 368 U. S. 890, 82 S. Ct. 139, 7 L. Ed. 2d 87; National Latex Products Co. v. Sun Rubber Co., 274 F. 2d 224, 239 (C. A. 6), cert. denied, 362 U. S. 989, 80 S. Ct. 1078, 4 L. Ed. 2d 1022. However, this Court has said

many times that if a device lacks invention then no amount of commercial success can validate the patent. Harvey v. Levine, 322 F. 2d 481, 486 (C. A. 6); Aluminum Co. of America v. Sperry Products, Inc., supra; Cold Metal Products Co. v. E. W. Bliss Co., 285 F. 2d 244, 248 (C. A. 6), cert. denied, 366 U. S. 911, 81 S. Ct. 1085, 6 L. Ed. 2d 235.

Plaintiff also points to the fact that its patents have been declared valid by a number of courts. In support of this, plaintiff puts forward a number of consent decrees which resulted from infringement suits brought by plaintiff against various small companies. We are of the view that these consent decrees are in no sense controlling. In a similar situation, this Court said "the consent decrees are not convincing. * * * the purchase of peace * * * is often a wise course for the small manufacturer." Kay Jewelry Co. v. Gruen National Watch Case Co., 40 F. 2d 600, 604 (C. A. 6). See also, Picard v. United Aircraft Corp., 128 F. 2d 632, 641-642 (C. A. 2) (Frank, J., concurring), cert. denied, 317 U. S. 651, 63 S. Ct. 46, 87 L. Ed. 524.

It is to be noted that when these patents did go to trial they were declared invalid. Monroe Auto Equipment Co. v. Superior Industries, Inc., 220 F. Supp. 941 (S. D. Cal.).

The District Court, in the instant case, also held that Claims 2 and 3 of patent 938 were anticipated by a prior device and therefore lacked novelty and were invalid under 35 U. S. C. § 102(a).

To digress momentarily to discuss some ground rules, anticipation belongs with novelty. To be patentable, a device must possess novelty as well as invention and utility. Novelty does not exist if the patented device has been anticipated by a prior device, whether patented or not. In order to have anticipation, it is necessary that all of the elements of the patented device, or their equivalents, be found in a single prior device where the elements do substantially the

same work in substantially the same way. Firestone v. Aluminum Co. of America, 285 F. 2d 928, 930 (C. A. 6); Allied Wheel Products v. Rude, 206 F. 2d 752, 760 (C. A. 6); 1 Walker, Patents § 47, at 255 (Deller ed.). In other words, a device lacks novelty if there is, or has been, a substantially identical prior device.

We must be careful to make the distinction between novelty and invention in relation to anticipation. Novelty and invention are two separate tests, and anticipation belongs only with novelty. This Court has pointed out that some courts tend, mistakenly, to use anticipation as an equivalent of invention. Allied Wheel Products v. Rude, supra, 206 F. 2d at 761; Firestone v. Aluminum Co. of America, supra. See also, Borkland v. Pedersen, 244 F. 2d 501, 502 (C. A. 7). Thus it is incorrect to say that a patent lacks invention because it is anticipated. If it is anticipated it lacks novelty; it lacks invention if it would have been obvious.

From this it should be clear that even though the prior art may not anticipate the patent in question, the disclosures of the prior art may negative invention. Harvey v. Levine, 322 F. 2d 481, 483 (C. A. 6); Allied Wheel Products v. Rude, supra, 206 F. 2d at 760; Leishman v. General Motors Corp., 191 F. 2d 522, 530 (C. A. 9); Seymour v. Ford Motor Co., 44 F. 2d 306, 309 (C. A. 6). That is, a prior device may not be substantially identical to the patented device and therefore cannot anticipate; however, it may be that in the light of this prior device the patented device would have been obvious.

In order to anticipate, a prior device, though it does not have to be patented, must have been reduced to use and successfully performed. National Latex Products Co. v. Sun Rubber Co., 274 F. 2d 224, 233 (C. A. 6), cert. denied, 362 U. S. 989, 80 S. Ct. 1078, 4 L. Ed. 2d 1022; Stearns

v. Tinkor & Rasor, 220 F. 2d 49, 56 (C. A. 9), cert. denied, 350 U. S. 830, 76 S. Ct. 62, 100 L. Ed. 741; Simmons v. Hansen, 117 F. 2d 49, 51 (C. A. 8); Oliver Machinery Co. v. Gellman, 104 F. 2d 11, 13 (C. A. 6); Gaiser v. Linder, 45 C. C. P. A. 846, 253 F. 2d 433. It must have been a public use, although it need not be a commercial use. Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358, 384, 48 S. Ct. 380, 72 L. Ed. 610. Sometimes the word experimental is used in contrast to public use. However, in certain situations, the difference between a public use and an experimental use is not so clear as to admit of this being a wholly adequate standard. Furthermore, courts have found sufficient reduction to use even though what was done would, by ordinary standards, be called experimental. E. g., Picard v. United Aircraft Corp., 128 F. 2d 632 (C. A. 2), cert. denied, 317 U. S. 651, 63 S. Ct. 46, 87 L. Ed. 524. Suffice it to say that there must have been a reduction to use which was, to some extent at least, a public use.

With these principles in mind, we turn to consider whether claims 2 and 3 of patent 938 lacked novelty because anticipated by a prior device. We reemphasize the fact these claims relate to the non-metallic spacer sleeve between the shock absorber and the coil spring. We note that the patent date of 938 is May 6, 1954.

From the record the following facts are clearly established: in 1953, Fred Knoedler, President of Knoedler Manufacturers and holder of Patent 2,632,544 relating to a tractor seat support, put a coil spring around a standard shock absorber and installed such a device on his own car. This proved unsatisfactory because of the noise caused by the spring banging against the shock absorber. To remedy this, Knoedler put first a rubber and then a plastic sleeve around the shock absorber to prevent the spring from bang-

ing against it. Thus satisfied, Knoedler had sales literature prepared for the purpose of marketing his device under the name of a Hydro Shock Booster Spring. This literature was subsequently distributed, to a limited extent at least, by Knoedler and his son.

On September 1, 1953, Knoedler, through his attorneys, filed a patent application on this device. This application indicates a non-metallic sleeve around the shock absorber. This application was allowed, but a patent was never issued because of the failure to pay the final fee.

Finally, it is established that Knoedler made up six sets of these springs which were installed on his two cars, and on cars belonging to his son, two employees, and a mechanic. The springs operated successfully, and we hold that this constituted a sufficient reduction to public use.

These facts clearly demonstrate that the Knoedler device was prior to patent 938, that it consisted of substantially the same elements operating in the same manner, and that it was sufficiently reduced to a public use. We hold that these facts establish anticipation and therefore claims 2 and 3 of patent 938 are invalid for lack of novelty. See Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358, 48 S. Ct. 380; Brush v. Condit, 132 U. S. 39, 10 S. Ct. 1, 33 L. Ed. 251; Coffin v. Ogden, 18 Wall. 120, 85 U. S. 120, 21 L. Ed. 821.

Plaintiff makes much of the fact that Knoedler abandoned his device. The answer to this contention is that if the prior device has been reduced to practice then it can negative novelty even though it is subsequently abandoned. Corona Cord Tire Co. v. Dovan Chemical Corp., 276 U. S. 358, 48 S. Ct. 380; Rosaire v. Baroid Sales Div., National Lead Co., 218 F. 2d 72 (C. A. 5), cert. denied, 349 U. S. 910, 75 S. Ct. 605, 99 L. Ed. 1249; Picard v. United Aircraft Corp., 128 F. 2d 632 (C. A. 2), cert. denied, 317

U. S. 651, 63 S. Ct. 46. As the Supreme Court said in the first-cited case: "It is doubtless true that Kratz by his course in respect to his discovery as to the use of D. P. G. has abandoned any claim as against the public for a patent, but that is a very different thing from saying that it was abandoned as against a subsequent discoverer or patentee." 276 U. S. at 384-385, 48 S. Ct. at 388.

Similarly, plaintiff argues that Knoedler's abandoned patent application cannot be used to anticipate plaintiff's patent. It is true that an abandoned patent application cannot be used in itself to anticipate; however, it can, as here, be used as evidence of the prior device. U. S. Blind Stitch Mach. Corp. v. Reliable Mach. Works, 67 F. 2d 327, 328 (C. A. 2); Curtiss-Wright Corp. v. Link Aviation, Inc., 182 F. Supp. 106, 118 (N. D. N. Y.); Application of Schlittler, 43 C. C. P. A. 986, 234 F. 2d 882, 885.

We come now to plaintiff's patent 235 of which claim 14 is the only claim in suit. Claim 14 relates to the combination shock absorber and overload spring assemblies being installed in an angular or "sea-leg" fashion in the rear suspension of an automobile. The District Court held this claim invalid for lack of invention.

The so-called sea-leg mounting is old and well known in the art. In the S. A. E. Journal for May, 1949, it was noted: "most cars have adopted what is known as the sea-leg mounting for the rear shock absorbers." See Monroe Auto Equipment Co. v. Superior Industries, Inc., 220 F. Supp. 941, 944 (S. D. Cal.).

Italian Patent 466,870 discloses a shock absorber and spring arrangement mounted in a sea-leg fashion. French Patent 1,044,393 and Italian Patent 467,071 disclose a shock absorber disposed within a coil spring and mounted in sea-leg fashion. U. S. Patent 2,159,203 discloses a standard shock absorber in a sea-leg mounting.

Plaintiff contends that in these prior art patents the suspension devices perform in a different manner or serve a different purpose than in patent 235 and therefore they cannot be used to anticipate. This might be true if we were concerned here with novelty. However, as we hereinabove have pointed out, the fact that none of these prior art references are so like patent 235 that they could negative novelty does not mean that they may not negative invention.

As before, plaintiff contends that it is the unique combination of this particular suspension system with this particular mounting which constitutes invention. As we said a combination of old elements may create a patentable device, provided the quality of invention is present. We find no such quality here. Plaintiff's use of the sea-leg mounting was a mere expediency and not an exercise of the inventive faculty.

We conclude, then, that plaintiff's improvement over the prior art would have been obvious to one skilled in the art, and therefore claim 14 of patent 235 is invalid for lack of invention.

Furthermore, we hold that claim 14 of patent 235 is invalid for lack of novelty as it was anticipated by the Knoedler device discussed above. In addition to testimony, there was documentary evidence that Knoedler's suspension device was mounted in a sea-leg fashion. Plaintiff attempts to overcome this by saying that it was not reduced to practice. As we have already pointed out, it is clear that Knoedler made six sets of his device which were put on different cars and operated successfully.

In addition, one of the six sets was given to one John Truesdon, an employee of Knoedler, who installed the set in a sea-leg mounting. In August, 1953, Truesdon sold his car with the Knoedler device still mounted in the same way. Since this sale was more than a year prior to the filing date

of patent 235, claim 14 of said patent is invalid under 35 U. S. C. § 102(b).

We hold that these clearly established facts constitute anticipation and therefore claim 14 of patent 235 is invalid for lack of novelty.

The District Court also held, and defendant has argued in this Court, that the pertinent claims of both patents were also invalid under Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Corp., 315 U. S. 759, 62 S. Ct. 865, 86 L. Ed. 1171. The so-called Muncie Gear doctrine is that a claim which adds new matter to the original application is invalid if filed more than one year after public use of the device. If the later claim is only a clarification or refinement of matter which has been sufficiently disclosed in the original application or drawing then it is allowable. As a practical matter, new claims are constantly being added to an application, sometimes more than one year after the device has gone into public use. Thus the question is whether there is anything in the prior disclosures which will support the subsequent claim, or does the claim broaden or change the original invention. This Court has discussed and applied the Muncie Gear doctrine in National Latex Products Co. v. Sun Rubber Co., 274 F. 2d 224 (C. A. 6), cert. denied, 362 U. S. 989, 80 S. Ct. 1078; Coats Loaders & Stackers, Inc. v. Henderson, 233 F. 2d 915 (C. A. 6); Cold Metal Process Co. v. Republic Steel Corp., 233 F. 2d 828 (C. A. 6), cert. denied, 352 U. S. 891, 77 S. Ct. 128, 1 L. Ed. 2d 86.

Since, however, we have held the relevant claims of these two patents invalid for lack of invention and lack of novelty, we do not deem it necessary to discuss the issue of late claiming which might be posed by this case.

Similarly, because of the invalidity, we do not reach the question of infringement. Cold Metal Products Co. v. E. W.

Bliss Co., 285 F. 2d 244, 250 (C. A. 6), cert. denied, 366 U. S. 911, 81 S. Ct. 1085, 6 L. Ed. 2d 235; Bergman v. Aluminum Lock Shingle Corp. of America, 251 F. 2d 801, 804 (C. A. 9).

Throughout our disposition of this case we have not been unmindful of plaintiff's right to a jury trial. We are of the opinion, however, that the facts were clearly established and that there were no factual issues to be resolved by a jury. Therefore plaintiff was not prejudiced by the denial of a jury trial.

For the reasons hereinabove discussed, the judgment of the District Court is affirmed.

APPENDIX B

Constitutional and Statutory Provisions

U. S. CONSTITUTION, AMENDMENT VII

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

PATENT ACT OF 1952, 35 U. S. C.

§ 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent

* * *

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.